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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,415	03/15/2004	Tomas Smetana	P/4476-3	1960
2352 7590 09/25/2007 OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			EXAMINER AFZALI, SARANG	
			ART UNIT 3726	PAPER NUMBER
			MAIL DATE 09/25/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/801,415

Applicant(s)

SMETANA ET AL.

Examiner

Sarang Afzali

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE filed 7/9/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08).
Paper No(s)/Mail Date 7/9/2007.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/9/2007 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites "the outer machine part and the external circumferential surface of the inner machine part are fastened one over the other by means of compression connection, . . . ". However, it is unclear what is meant by "compression connection". The specification does not describe what this assembly process encompasses. In

addition, there are no figures that show how the outer machine part is actually assembled to the inner machine part. What is shown in the figures is the final product.

3. Claims 1-6 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has included the new limitation "radially overlap". There is no support in the original disclosure for the term "radially overlap".

4. Claims 1-6 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 now includes the limitation "outer machine part is deformed radially outward". There is no support in the original disclosure for deforming the outer machine part radially outward. There is no mention of the way the compression connection is obtained in applicant's specification.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Russ et al. (US 5,787,933). Russ et al. teaches a subassembly comprised of at least two machine parts including: an outer machine part (1, Fig. 1) having an internal circumferential surface and a cooperating inner machine part (3, Fig. 1) having an external circumferential surface wherein the internal circumferential surface of the outer machine part and the external circumferential surface of the inner machine part are fastened one the other forming a leakproof compression joint (col. 1, lines 41-46) such that the outer and inner machine parts being so positioned along an axis with respect to each other that they overlap and the dimensions of the inner and outer machine parts radially overlap and respective materials hereof are selected such that the outer machine part is deformed radially outward into the plastic range of material strain (Fig. 1, col. 2, lines 26-34).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by Franke (US 6,267,712) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Franke in view of either one of Wuensch (US 6,942,558) or Rosko (US 6,120,045).

As applied to claims 1 and 2, Franke teaches a subassembly comprised of at least two machine parts including: an outer machine part (4 comprising a tensioning roller 3, Figs.1 & 2) having an internal circumferential surface and a cooperating inner machine part (5 comprising a raceway ring of a bearing 6, Figs. 1 & 2) having an external circumferential surface wherein the internal circumferential surface of the outer machine part and the external circumferential surface of the inner machine part are fastened one the other such that the outer and inner machine parts being so positioned along an axis with respect to each other that they overlap and the dimensions of the inner and outer machine parts radially overlap.

Regarding the limitation of "compression connection", "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 985).

9. As applied to claims 1 and 2, in alternative, if applicant does not agree that Franke teaches the "compression connection", Wuensch or Rosko, as admitted by the

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applicant, teach the well-known method of compression connection used in forming an assembly of inner and outer members.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention to have provided the invention of Franke with the claimed compression connection, which is considered to be well known as stated by Wuensch or Rosko (AAPA), in order to Provide a secure connection between the inner and outer machine parts.

10. Claims 3-6 are rejected under 35 U.S.C. 103(a) as obvious over Franke in view of either one of Wuensch or Rosko.

Regarding the limitations of claim 3 pertaining to the contraction of the inner machine part corresponding to the level of contraction of the outer machine part at maximum overlap of the compression connection for elastic deformation of the outer machine part and the limitations of claim 4 pertaining to the contraction of the inner machine part corresponding to the level of contraction of the outer machine part at maximum overlap of the compression connection for elastic deformation of the outer machine part, note that: "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

Regarding claims 5 and 6, the particular dimensions of the raceway ring and running disk is considered to be an obvious matter of design to a person of ordinary skill in the art, at the time of the invention, depending upon the desired strength characteristics and side that the pressure roller needs to be. In addition, official notice is taken that the claimed sizes are well known to a person of ordinary skill in the art when creating bearings.

Response to Arguments

11. Applicant argues in the response filed 7/9/2007 (Remarks, pages 1-2) that the limitation of "compression connection" is definite and that one of ordinary skill in the art would have been able to obtain a compression connection in order to practice the Applicant's invention and that a search of the patent literature for the term "compression connection", which was not reflected in the Examiner's EAST search notes of record, would have uncovered, for example, U.S. Patent Nos. 6,942,558 to Wuensch ("Wuensch"), and 6,120,045 to Rosko ("Rosko"). Wuensch describes a "compression connection" between a flange (28) and a housing part (30) without further elaboration. Col. 2, lines 62-67. Wuensch recites the same "compression connection" as the sole limiting feature of dependent claim 3.

The Examiner maintains the previously stated rejection of claims 1-6 (office actions mailed on 2/9/2007) under 35 USC 112 first paragraph regarding enablement. The Applicant argues (Remarks, page 5, paragraphs 1 & 2) as why the radially outward

deformation in the plastic range of the outer machine part would exhibit different characteristics than in an elastic range.

However, Applicant is advised to disclose or clarify how the claimed "compression connection" is achieving this feat? The disclosure is not enabling as what exactly is this "compression connection" that would only produce a radially outward deformation of the outer member in the plastic range of the outer member and how would it be different from a "compression connection" technique that is producing a radially inward deformation of the outer member in a plastic range or a radially outward deformation of the outer member in an elastic range? What different steps Applicant's compression connection has over other compression connection steps?

The Applicant needs to clarify what exactly is the claimed invention? Is Applicant claiming a method of "compression connection" that causes the desired deformation in the desired range and direction? Or is Applicant claiming the final product that exhibit the desired characteristics?

The Applicant argues (Remarks, page 2, last paragraph) that a simple search in EAST would have uncovered Wuensch and Rosko references that teach compression connection. The Examiner assumes that the only reason Applicant is citing these references, is that they teach a well-known state of the art method of compression connection. Therefore, the Examiner considers Wuensch and Rosko as Applicant Admitted Prior Art and as such, Wuensch and Rosko explicitly teach the limitation of "compression connection" as recited in claim 1 that result in the desired deformation in the desired direction.

The Applicant argues (Remarks, page 3, last paragraph, page 4, paragraphs 1-2) that "All of relevant dimensions - inner diameter of the running disk, outer diameter of the raceway, thickness of the running disk - are radial dimensions. Therefore, it would be apparent to one of ordinary skill in the art that the dimensional overlap recited in claim 1 is a radial overlap. The amendment merely makes explicit what was implicit in the disclosure. In light of this, having read the specification, one of ordinary skill in the art would recognize that the Applicant did have possession of the claimed invention, including that "the dimensions of the inner and outer machine parts radially overlap" and further argues that "Moreover, it would also be apparent to one of ordinary skill in the art that where there is a overlap or radial dimension between two cylindrical parts, regardless of the context, "the outer machine part is deformed radially outward" as recited in claim 1. The relationship between the inner and outer machine parts recited in claim 1, i.e. a radial overlap, can deform the outer machine part in only one direction, outward".

Again, the Examiner maintains the previously stated rejections of claims 1-6 (office actions mailed on 2/9/2007) under 35 USC 112 first paragraph regarding the limitations of "radially overlap" and "outer machine part is deformed radially outward".

As for the limitation of "radially overlap", given the broadest reasonable interpretation of the claimed language, the Examiner considers any tube inserted inside another tube, even partially, would have radial overlap sections in addition to a longitudinal overlap at that particular joint section. As such, the Examiner does not

agree with any other special definition that the Applicant may assign to the phrase "radial overlap".

As for the limitation of "deformed radially outward", the Examiner disagrees with Applicant arguments, since the Applicant is not disclosing how the compression connection is obtained that would result in a radially outward plastic deformation of the outer member, therefore, it is conceivable that there is a radially inward deformation of the outer member due the compression connection technique.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarang Afzali whose telephone number is 571-272-8412. The examiner can normally be reached on 7:00-3:30 M-F.

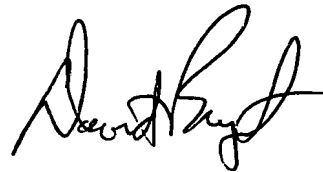
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on 571-272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



SA
9/20/2007



DAVID P. BRYANT
SUPERVISORY PATENT EXAMINER

9/20/07